

Group I, Claims 1-9 and 11, drawn to a system and platform to facilitate a dynamic availability of eCommerce services to a user over the Internet wherein a web server providing information to a browser of a user which information is configured to allow notification of eCommerce services provided to be made available via Internet to the user, and, a lookup server configured to dynamically send the notification to the user of the availability of the eCommerce services, classified in class 709, subclass 200;

Group II, Claims 12-22, drawn to method and apparatus for providing dynamic availability of eCommerce services via a web server by maintaining database of user information, including authentication and access control information; logging a user in with the web server based on the information accessed in the database; using an authentication servlet to conduct user authentication and display available servers to the user; wherein if a new service is created and started while the user is logged in the web server, and, the user has authorization to access said new service, lookup server causes information pertaining to new services to dynamically appear in client applet, classified in class 705, subclass 1.

It is the Examiner's position that the inventions listed as Groups I and II are distinct from each other.

In response to the Examiner's requirement for restriction, applicants provisionally elect with traverse to prosecute the subject matter of Group I, Claims 1-9 and 11. However, applicants reserve the right under 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected claims in this application.

Before addressing the merits of the Restriction Requirement, it should be noted that the Office Action has described subject matter in Groups I and II on the basis of the subject matter in the independent claims. Thus it should be noted that subject matter within the scope of

the identified claims in Groups I and II is broader than just the description set forth in the Office Action. It is to be noted that in responding to the Restriction Requirement, applicant has assumed that the characterization of Groups I and II are as outlined above. Nevertheless, such assumption should not be considered an acquiescence by applicant that it agrees with the characterization of the subject matter recited in Groups I and II.

As indicated hereinabove and in order to be fully responsive to the requirement for restriction imposed by the Office Action, applicant provisionally elects, with traverse, the subject matter of Group I, i.e., Claims 1-9 and 11.

In accordance with the foregoing, applicant hereby traverses, pursuant to 37 C.F.R. §§ 1.111 and 1.143, the requirement for restriction and requests reconsideration thereof in view of the following remarks.

Applicant respectfully requests that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more independent and distinct inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distant inventions are found within one application. Only the statutory requirement that the various groups are “distinct” has been proffered as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness, there is absolutely no indication in the Office Action that Groups I and II are also independent. In fact, applicant submits that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are un connected in design, operation or effect...

Applicant respectfully submits that the subject matter in Groups I and II are connected in design, operation or effect and are thus not independent.

Consequently, because the Office Action has not even alleged the statutory required "independence" of these groups and further because these groups of claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately are not "independent and distinct", so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

In addition, the Examiner alleges that inventions I and II are related as subcombination and combination and that the inventions are distinct in accordance with MPEP § 806.5 (c). The Examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because invention I sends notification to a user which can be performed in a plurality of ways, for example, via an e-mail, whereas, invention II, new services will appear in client's applet (client applet is modified)". However, the Examiner has not established that the subcombination of claim 12 has utility in other combinations pursuant to MPEP § 806.5 (c).

In addition, the courts have recognized that it is in the public interest to permit an applicant to claim several aspects of his or her invention together in one application, as the applicant has done herein, so as to encourage the applicant to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicant respectfully suggests that in view of the continued increase of official fees and the potential limitation of applicant's financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), the applicant is required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of his or her patent assets.

It is vital to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention-double-patenting,

Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288

U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not

insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicant respectfully urges the United States Patent and Trademark Office not to require restriction in cases such as the present application.

The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This, of course is error. It simply does not comply with the provisions under 35 U.S.C. §121. (See In re Kuehl, *supra*).


The classification system is an unreliable basis for requiring restriction between claims to the various aspects of applicants’ unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent the United States Patent and Trademark Office from basing patentability decisions, as to claims assigned to one group, on patent references found in the subclass(es) with which the United States Patent and Trademark Office associates another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

In view of the foregoing, an examination on the merits of the elected claims, at an early date, is earnestly solicited.

Respectfully submitted,

  
Paul J. Esatto, Jr.  
Reg. No. 30,749

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
PJE:ahs:ae